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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,461

01/22/2004

Marvin R. Blumberg

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06/13/2006

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EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,461

Applicant(s)

BLUMBERG, MARVIN R.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-57, 59 and 60 is/are rejected.
- 7) ☒ Claim(s) 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application, and preliminary amendment filed on 1/22/2004.

This action is made Non-Final.

2. In the amendment, claims 1-53 have been canceled. Claims 54-60 have been added, and are pending in the case. Claim 1 is an independent claim.

Priority

3. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 120, and 119(e), and based on U.S. provisional application # 60/117,246, CIP of 09/912,509(Pat.6,799,303), and PCT/US00/01890 filed on 1/26/1999, 7/26/2001, 1/26/2000, which papers have been placed of record in the file.

Drawings

4. The drawings filed on 1/22/2004 have been accepted by the Examiner.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

Art Unit: 2178

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 54-57, and 59-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,799,303, hereinafter 303, in view of Blumberg (Pat.# 5,664,896, 9/9/1997), hereinafter 896.

Regarding independent claim 54, claim 6 of 303 fails to explicitly teach *a keyboard having at least thirteen operator-selectable letter input elements*. However, 896 teaches associating several letters with each key in a keyboard, having 14 keys, for entering desired letters for high speed entry of text. Words which match the sequence of letter keystrokes are presented to the user-- (col.13, lines 4-20, 50-col.14, line 54, and fig.9). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Regarding claim 55, which depends on claim 53, 303, and 896 fail to explicitly disclose: *one of the letter input elements includes the letters A and B, one of the letter input elements*

Art Unit: 2178

includes the letters E and F and one of the letter input elements includes the letters T and U.

However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because 896 teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 56, which depends on claim 53, 303 fails to explicitly teach *one of the letter input elements includes at least the letters J and K*. However, 896 discloses a key that is assigned the letters “J”, “K”, and “Q” (fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Regarding claim 57, which depends on claim 53, 303 fails to explicitly teach *a one of the letter input elements includes at least the letters V and W*. However, 896 discloses a key that is assigned the letters “V” through “Z”, etc (fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Regarding claim 59, which depends on claim 53, 303, and 896 fail to explicitly teach *two of the letter input elements include a letter selected H and a letter selected from the from the group of letters G and group of letters I and O*. However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because 896 teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Regarding claim 60, which depends on claim 53, 303 fails to explicitly teach *a one of the letter input elements includes the letter U and a letter selected from the group of letters R, S and T*. However, 896 discloses inputting text with keys that are assigned the letters “P, U”, and “R” (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because of all the reasons included in 896 above including reducing finger and hand movement and fatigue (col. 13, lines 8-12).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2178

8. Claims 54, 56-57, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Blumberg (Pat.# 5,664,896, 9/9/1997).

Regarding independent claim 54, Blumberg discloses associating several letters with each key in a keyboard, having 14 keys, for entering desired letters for high speed entry of text. Words which match the sequence of letter keystrokes are presented to the user-- *A method for entering letters of an alphabet using a computer having a display device, memory storage and a keyboard having at least thirteen operator-selectable letter input elements, the method comprising assigning more than one letter to at least one letter input element of the keyboard with a majority of the letter elements having only two letters assigned each letter input element such that more than one series of letters results from a single selected letter input element, storing a plurality of words in the memory storage, and displaying on the display device for each entered letter input element, a series of letters that form at least one valid combination, said at least one valid combination being determined from said plurality of stored words the memory storage for a same number of the letter input elements thus far selected--* (col.13, lines 4-20, 50-col.14, line 54, and fig.9).

Regarding claim 56, which depends on claim 53, Blumberg discloses a key that is assigned the letters "J", "K", and "Q" (fig.9-10).

Regarding claim 57, which depends on claim 53, Blumberg discloses a key that is assigned the letters "V" through "Z", etc (fig.9-10).

Regarding claim 60, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters "P, U", and "R" (col.13, lines 4-20, 50-col.14, line 54, fig.9-10).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 55, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg.

Regarding claim 55, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters "P, U", and "R" (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *one of the letter input elements includes the letter A and B, one of the input elements includes the letters E and F, and one of the letter input elements includes the letters T and U*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Art Unit: 2178

Regarding claim 59, which depends on claim 53, Blumberg discloses inputting text with keys that are assigned the letters "P, U", and "R" (col.13, lines 4-20, 50-col.14, line 54, fig.9-10). Blumberg fails to explicitly disclose: *two of the letter input elements include a letter selected H and a letter selected from the from the group of letters G and group of letters I and O*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have provided such keys, because Blumberg teaches including vowels and consonants into one key so that fewer words have the incidence of the same code (col. 5, lines 25-40).

Allowable Subject Matter

11. Claim 58 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Capps et al. (Pat. # 5,666,502 A), Grover et al. (Pat. # 5,818,437 A), Comer et al. (Pat. # 5,845,300 A), Laakkonen (Pat. # 6,043,760 A), Hatchamovitch et al. (Pat. # 6,377,965 B1), and Ortega et al. (Pat. # 6,401,084 B1).

II. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

Art Unit: 2178

Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:


Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
6/12/06